

O/561/18

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 3237641
BY COPESTICK MURRAY LIMITED
FOR THE TRADE MARK**

SILENT PEAK

IN CLASS 33

AND

**THE OPPOSITION THERETO UNDER NO. 410286
BY ALBURY VINEYARD LTD**

Background and pleadings

1. Copestick Murray Limited (formerly Copestick Murray Wine Solutions Limited) (the applicant) applied to register the trade mark SILENT PEAK in the UK on 15 June 2017. It was accepted and published in the Trade Marks Journal on 23 June 2017 in respect of the following goods:

Class 33:

Wine

2. Albury Vineyard Ltd (the opponent) opposes the trade mark under section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark No 3124973: SILENT POOL. The application for this mark was filed on 1 September 2015 and it was registered on 27 November 2015. The following goods are relied upon in this opposition:

Class 33:

Wines and wine-based beverages

3. The opponent argues that the respective goods are identical and that the marks are similar. It stresses the importance of the first part of the mark and the imperfect picture of the marks that the consumer will have in their mind. As a result, the opponent claims, there is “a strong likelihood of confusion between the Applicant’s mark and the Opponent’s earlier mark, including likelihood of association”.
4. The applicant filed a counterstatement on 27 November 2017. It denied the claims made and referred to the existence of other marks beginning with the word “SILENT” and covering identical or similar goods.
5. Both sides filed written submissions and the opponent filed written submissions in lieu of a hearing. These will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

6. In these proceedings, the opponent is represented by Inbrandgible Limited; the applicant is represented by Dr Walther Wolff & Co.

DECISION

7. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. An “earlier trade mark” is defined in section 6(1) of the Act as:

“a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

9. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provision. As this earlier mark was registered within the five years before the date on which the applicant’s mark was published, it is not subject to proof of use. In this opposition, the opponent is relying upon all the goods for which the mark stands registered. It is entitled to do so.

Case law

10. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be an individual reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The marks cover the goods listed in the table below:

Opponent's mark	Contested mark
Class 33 Wines and wine-based beverages	Class 33 Wine

12. The contested goods are identical to the goods covered by the earlier mark.

Average consumer and the purchasing act

13. In *Hearst Holdings and Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited and J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”¹

14. The average consumer is primarily an adult member of the general public. Those involved in the on-trade, such as restaurant and bar owners, will also be relevant.

15. Wines are available through a variety of trade channels – supermarkets, wholesalers or off-licences – where the selection is likely to be made by the consumer from a shelf. They may also be bought from a mail-order catalogue or a website, where the consumer will also select the goods visually. Wines are also sold through bars, restaurants, clubs and public houses, where the goods may be requested orally from a member of staff.

16. Even though the purchase of goods in a bar, restaurant, club or public house may involve an aural element, the selection will be made primarily visually, with the aid of a wine or drinks menu or from a display of goods on a shelf or in a fridge.

17. The level of attention paid to the purchase will vary depending on the nature of the goods. Wines can range in price from the relatively cheap bottles, cartons or

¹ Paragraph 60.

boxes, which are likely to be purchased fairly often, perhaps as part of a weekly supermarket shop, and will require a lower level of attention to be paid compared to the rare vintage wines that are sold at a high price and which are likely to be purchased with a relatively high level of attention. In any event, the level of attention paid will be that necessary to satisfy the consumer's tastes for style, grape, origin and age. I find that the average consumer will pay an average level of attention to ensure that the goods purchased meet their, or their customers', tastes.

Comparison of marks

18. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (CJEU) stated in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”²

19. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

20. The respective marks are shown below:

² Paragraph 34.

Earlier mark	Contested mark
SILENT POOL	SILENT PEAK

21. The applicant's mark consists of the words "SILENT PEAK", in a standard font with no stylisation and presented in capital letters. The overall impression of the contested mark rests in those words.
22. The opponent's mark consists of the words "SILENT POOL", in a standard font with no stylisation and presented in capital letters. The overall impression of the earlier mark rests in those words.
23. Both marks consist of two words, with the first of these being identical. The second word in each mark begins with the same letter ("P") and has the same number of letters (4). Consequently, I find that the marks have a good degree of visual similarity.
24. The first words are identical in sound as well as appearance. The identical first letter of the second words are followed by different vowel sounds and final consonants: "-OOL" and "-EAK" (pronounced as "-EEK"). These phonemes have different characters. The opponent's "-OOL" is soft and liquid, while the applicant's "-EAK" has a more percussive quality. I find that the marks are aurally similar to at least a medium degree.
25. The opponent argues that the marks are conceptually similar, with both evoking thoughts of the outdoors. The applicant disagrees, stating that they are different and that "the outdoors" is too general a concept to be relevant here. I agree with the applicant in that respect, but find a more specific similarity. Both names evoke a silent, natural location, albeit that one of these locations is water and the other a hill or mountain. Consequently, my finding is that there is some conceptual similarity, but this is at a medium level.

Distinctive character of the earlier trade mark

26. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer v Klijsen Handel BV*, C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, that national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1990] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27. The opponent did not submit any evidence to show that it has used its mark, so I must consider only the question of inherent distinctiveness. The words “silent pool” do not describe, or allude to wines or wine-based beverages, but do have meanings that are found in the dictionary and known to the average consumer. Accordingly, I find that the mark has a medium level of distinctiveness.

Conclusions on likelihood of confusion

28. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and must now present my conclusions, taking a global perspective. Guidance on such a perspective has been provided by the CJEU in *Canon Kabushiki Kaisha*:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”³

29. It is not relevant that, as pointed out by the applicant, the register already contains marks beginning with the word “SILENT” that cover the same goods. In *Zero Industry Srl v OHIM*, T-400/06, the General Court held that:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard that ‘... there are no indications as to how many of such trade marks are effectively used in the market’.”⁴

30. The goods in question are identical and earlier in the decision I found that there were similarities between the marks to varying degrees, depending on whether one were considering the visual, aural and conceptual aspects of the marks. In

³ Paragraph 17.

⁴ Paragraph 73.

New Look Limited v OHIM, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”⁵

31. The opponent argues that the degree of aural similarity is “particularly relevant” as wines are often ordered orally in noisy environments. However, the General Court has thrown doubt on this line of argument. Even in the case of noisy bars and restaurants, wine is normally chosen from a wine list, showing the mark: see *Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co KG v European Intellectual Property Office (EUIPO)*, T-187/17. Consequently, I find that the visual and conceptual aspects of the marks have more weight than the aural, when making an assessment of the likelihood of confusion.
32. There are two types of confusion: direct and indirect. These were explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

⁵ Paragraph 49.

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”⁶

33. Where there is imperfect recollection of marks, direct confusion may occur. It is accepted that the average consumer does not have in their mind a perfect picture of the marks in question. However, the applicant has argued that this will be a considered purchase, and so the concept of imperfect recollection is not relevant. Earlier in this decision, I found that the average consumer pays an average level of attention during the purchasing process. This is a lower level than would be associated with a considered purchase and therefore imperfect recollection cannot be dismissed.
34. The opponent claims that in general the average consumer attaches greater importance to the first part of the mark. The applicant states that this is not a hard and fast rule. In this the applicant is correct. However, the tendency to focus more on the start of the mark is one element to be considered as part of the global assessment. Combined with the identity of the goods, the medium level of distinctiveness of the earlier mark, and the conceptual similarities, the high visual similarity (and identity of the first words) leads me to find that there is a likelihood of direct confusion as a result of imperfect recollection. The opposition therefore succeeds.

⁶ Paragraph 16.

Conclusion

35. The opposition has been successful. The application will be refused.

Costs

36. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee - £100

Preparing a statement and considering the other side's statement - £300

Preparation of submissions in lieu of a hearing - £300

Total - £700

37. I therefore order Copestick Murray Limited to pay Albury Vineyard Ltd the sum of £700. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 10th day of September 2018

Clare Boucher

For the Registrar,

Comptroller-General